

REMARKS

In an office action dated August 12, 2005, the Examiner rejected claims 1, 3, 4, 6, 7, 9, 13, 16, 17, 18, 20, 24, 27-29, 31 and 34 under 35 U.S.C. §102(e) as anticipated by Scheurich (U.S. Patent 6,665,453); rejected claims 2, 10 and 21 under 35 U.S.C. §103(a) as being unpatentable over Scheurich in view of Belz et al. (U.S. Patent Pub 2003/0090572); rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Scheurich in view of Official Notice; rejected claims 11 and 22 under 35 U.S.C. §103(a) as being unpatentable over Scheurich in view of Makishima et al. (U.S. Patent 6,549,307); and rejected claims 8, 12, 14, 19, 23, 25, 30 and 32 under 35 U.S.C. §103(a) as being unpatentable over Scheurich in view of Marchese (U.S. Patent 6,891,566). Claims 15, 26 and 33 were objected to as dependent on rejected base claims, but otherwise indicated to contain allowable subject matter.

Applicant has amended independent claims 1, 16 and 27 to incorporate, with a single exception, all the limitations of allowable claims 15, 26 and 33, respectively, including the limitations of dependent claims 14, 25 and 32, respectively, which were included in the chain of dependency. The exception is the single word “backwards” in claims 15, 26 and 33, which was changed to “back” in the amended independent claims for clarity. Dependent claims 14, 15, 25, 26, 32 and 33 have been cancelled as superfluous.

Scheurich discloses a digital imaging system having the capability to capture both high resolution still images and motion video images at a lower resolution. However, the key point of distinction between Scheurich and applicant’s invention, which the Examiner appears to have recognized by indicating allowability of certain dependent claims, is that Scheurich requires the user to indicate that the still image is to be saved contemporaneously with the capture of the image by the camera. In other words, Scheurich’s device works similar to a conventional camera, in that the user selection (pressing the shutter) causes the image to be captured at that moment in

time. Scheurich differs from the conventional camera in that the user can be capturing motion video at the same time as he is capturing still video and using the same device.

Applicant's invention, on the other hand, is intended to allow the user to make the decision to save a still image *after it has been captured*. Thus, the user can capture any amount of motion video, and, if the user realizes that something which has already occurred is worthy of preserving as a still image, then elect to save the still image. Specifically, as recited in the amended claims, the user plays the contents of the buffer and selects one or more still images for saving.

Original dependent claims 15, 26 and 33, which the Examiner indicated were allowable, recited that the portion to be saved is determined "by playing the contents of said buffer backwards to the user..." The word "backwards" was intended to convey nothing more than that the contents were played out from the buffer, i.e., during capture data is flowing into the buffer, and during playback it is flowing out of the buffer. However, the limitation "backwards" is ambiguous and could be interpreted to mean that the buffer contents are played in reverse chronological order. This interpretation would place an unnecessary and irrelevant limitation on the claim scope. In fact, as described in the preferred embodiment in the specification, the buffer contents are not played in reverse chronological order, but in forward chronological order. But in any case the order of play is not significant for patentability; it is the fact that the buffer contents are played after being captured. Accordingly, applicant has changed the word "backwards" to "back", to clarify that the claim limitation merely means data is played out of the buffer after being placed in the buffer, and not to place any limitation with respect to the order in which images from the buffer are presented to the user.

Independent claim 34 has been amended to incorporate analogous limitations and, as amended, is allowable for the same reasons that claims 1, 16 and 27 are allowable.

Applicant has further added new claims 35-40, dependent on claim 34. These new claims recite subject matter analogous to that recited in original dependent claims 6, 7, 9, 10, 11 and 12, and as dependent claims, are allowable for the same reasons that claim 34 is allowable. No new matter is introduced.

In view of the foregoing, applicant submits that the claims are now in condition for allowance and respectfully requests reconsideration and allowance of all claims. In addition, the Examiner is encouraged to contact applicant's attorney by telephone if there are outstanding issues left to be resolved to place this case in condition for allowance.

Respectfully submitted,

BLAIR WYMAN

By: 

Roy W. Truelson

Registration No. 34,265

Telephone: (507) 202-8725

Docket No.: ROC920010233US1
Serial No.: 10/021,819